

## REMARKS

In the non-final Office Action mailed May 1, 2002 ("Office Action"), the Patent Office stated that claims 1-20 are pending and that claims 1-20 stand rejected.

### **Allegation that applicants have not complied with one or more conditions for receiving the benefit of an earlier filing date:**

In the Office Action, the Patent Office alleged that the applicants have not complied with one or more conditions for receiving the benefit of an earlier filing date. Without disclaimer, prejudice, or presumption, the specification is amended herein such that this allegation should now be rendered moot.

### **Allegation that the declaration is defective**

In the Office Action, the Patent Office alleged that the declaration is defective in that the title of the invention in the declaration is different than the title of the invention on the first page of the specification. A corrected declaration is in preparation and will be submitted as soon as practicable.

### **Objection to the abstract**

In the Office Action, the Patent Office objected to the language of the abstract as filed. Without disclaimer, prejudice, or presumption, the abstract is amended herein such that this objection should now be rendered moot. In light of the amendments, the applicants respectfully request that this objection be reconsidered and withdrawn.

### **Objection to the specification**

In the Office Action, the Patent Office objected to the disclosure due to various informalities. Without disclaimer, prejudice, or presumption, the disclosure is amended herein

such that this objection should now be rendered moot. In light of the amendments, the applicants respectfully request that this objection be reconsidered and withdrawn.

**Rejection of claims 6, 7, 10-12, and 17-20 under 35 U.S.C. § 112, 2nd paragraph**

In the Office Action, the Patent Office rejected claims 6, 7, 10-12, and 17-20 under 35 U.S.C. § 112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that that applicant regards as the invention.

The Patent Office rejected claims 6, 7, 10-12, and 17-20 on the grounds that the recitation of percentages in these claims allegedly renders them indefinite since the percentages are not specific as to percentage by weight or percentage by volume. The applicants respectfully disagree with the Patent Office's assertions in view of the level of ordinary skill of a person skilled in the art to which the invention pertains.

A person of ordinary skill in the art to which the invention pertains would know that sodium dodecyl sulfate (SDS) is a solid compound and must be dissolved in solution to a given weight percentage (*i.e.*, a given amount of solid SDS must be weighed out, added to a given volume of solution, and mixed until dissolved) prior to use in compositions of the type claimed in the present application. Therefore, a person of ordinary skill in the art to which the invention pertains would know that the percentages of SDS as recited in the claims at issue would be percentages by weight.

Similarly, a person of ordinary skill in the art to which the invention pertains would know that ethylene glycol is a liquid compound and must be mixed with a solution to a given volume percentage prior to use in compositions of the type claimed in the present application. Therefore, a person of ordinary skill in the art to which the invention pertains would know that the percentages of ethylene glycol as recited in the claims at issue would be percentages by volume.

In light of the foregoing, the applicants respectfully request that the rejection of claims 6-7, 10-12, and 17-20 under 35 U.S.C. § 112, 2nd paragraph, be reconsidered and withdrawn.

## Rejection of claims 1-20 under 35 U.S.C. § 103(a)

In the Office Action, the Patent Office rejected claims 1-20 under 35 U.S.C. § 103(a) as allegedly being obvious over Richards *et al.* (U.S. Patent No. 6,296,809; the '809 patent) in view of Hartman *et al.* (U.S. Patent No. 5,432,056; the '056 patent).

The applicants respectfully, yet strenuously, disagree with the Patent Office's allegations. None of the art cited by the Patent Office, alone or in any combination, mentions or even suggests the claimed invention.

As the Patent Office well knows, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to either modify or combine reference teachings. Also, there must be a reasonable expectation of success and the prior art reference or combined references must teach or suggest all of the claim limitations. Furthermore, both the teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art and not in the applicant's disclosure. Finally, the level of skill in the art cannot be relied upon to provide the suggestion to combine references. *In re Kotzab*, 217 F.3d 1365 (Fed. Cir. 2000); *Al-Site Corp. v. VSI Int'l, Inc.*, 174 F.3d 1308 (Fed. Cir. 1999); *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998); *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991); *In re Jones*, 958 F.2d 347; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

The '809 patent upon which the Patent Office bases this rejection only mentions SDS and ethylene glycol in the most general manner as "preferably added to the conditioning solution." No specific concentration or percentage are provided. With all due respect, the Patent Office erroneously states, in reference to the '809 patent, that "[t]he conditioning composition has a known molarity, pH and composition." Close examination of the disclosure of the '809 patent reveals that not a single specific concentration or percentage are given for SDS and ethylene glycol in the '809 patent. Thus, again with all due respect, it is difficult, if not impossible, to see how the disclosure of the '809 patent could possibly render the presently claimed compositions obvious to a person of ordinary skill in the art.

Similarly, while the '056 patent discloses a fixative formulation comprising a bisulfite salt in an acidic buffer, which may or may not be citrate buffer, the '056 patent does not mention,

or even suggest, the inclusion of SDS or ethylene glycol in the fixative formulation. In fact, the disclosure of the '056 patent mentions at numerous places that the preferred fixative formulation consists of only a bisulfite salt and an acidic buffer (*see e.g.*, column 2, lines 55-58; Example 1, column 3, lines 40-52; and Example 2, column 3, lines 54-60). Thus, the '056 patent teaches away from the compositions claimed in the present application.

None of the art cited by the Patent Office, either alone or in any combination, mentions, or even suggests, the compositions claimed in the present application. These compositions were solely the invention of the present applicants and first disclosed in the present application.

In light of the foregoing, the applicants respectfully request that the rejection of claims 1-20 under 35 U.S.C. § 103(a) be reconsidered and withdrawn.

## CONCLUSION

Entry of the amendments and consideration of the remarks herein is respectfully requested. The applicants respectfully submit that the pending claims are allowable. The applicants urge the Patent Office to contact the applicants' undersigned representative if it is believed this would expedite prosecution of the present application. Prompt issuance of a Notice of Allowance and passage of the claims to issue are respectfully requested.

Date: November 1, 2002

Respectfully submitted,



Mark L. Chael, J.D., Ph.D.

Patent Agent

Reg. No. 44,601

**McDONNELL BOEHNEN HULBERT & BERGHOFF**

300 South Wacker Drive, 32nd Floor

Chicago, Illinois 60606

Telephone: 312 913 0001

Facsimile: 312 913 0002